

Attorney Docket # 4925-98PUS

Serial No. **09/719,070**
Reply After Final Rejection, dated June 23, 2004
In response to Final Rejection dated March 23, 2004

REMARKS/ARGUMENTS

The Final Rejection mailed March 23, 2004 has been reviewed and carefully considered. Claims 1-20 are pending, with Claims 1 and 13 being in independent form. No amendments have been made in response, as none are believed necessary to respond to the March 23, 2004 Final Rejection.

In the March 23, 2004 Final Rejection, the Examiner rejected independent Claims 1 and 13, as well as Claims 2-12 and 14-20 dependent thereon, under 35 USC §103(a) as unpatentable over *Widegren et al.* (WO 97/34437; hereinafter *Widegren*) in view of *Veloso* (US 6,122,508; hereinafter *Veloso*) and *Malmstrom* (US 5,901,359; hereinafter *Malmstrom*).

The combination of *Widegren*, *Veloso*, and *Malmstrom* neither teaches nor suggests the invention claimed in independent Claims 1 and 13 of the present application.

However, before exploring the substantive reasons why this combination does not render the present claims obvious, it should be noted that in the applicant's previous Amendment dated March 5, 2004, applicant traversed the previous §103 obviousness rejection over *Widegren* and *Veloso* because there was no teaching, suggestion, or incentive to combine *Widegren* and *Veloso* in order to teach the claimed invention. Instead of responding to this traversal, the Examiner has added another reference to the combination in the March 23, 2004 Final Rejection.

As stated in MPEP §707.07(f), "[w]hen the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer and the substance of it." It is respectfully submitted that the finality of the rejection should be withdrawn at least because the Examiner has failed to answer the substance of the applicant's previous argument.

Since the Examiner has failed to answer the substance of the traversal, it is repeated here so that the Examiner may put a response on the record.

In order to make a *prima facie* case of obviousness, a teaching, suggestion, or incentive to combine the references in order to teach the claimed invention, must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary

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skill in the art. *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). However, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this case, the Examiner has not made a *prima facie* case of obviousness at least because there is no teaching, suggestion, or incentive to combine *Widegren* and *Veloso*.

In the present case, *Widegren* is directed to integrating a "private fixed telephony network (PTN) 108" and a private wireless office system of the same corporate entity, as was described above. *Veloso* is directed to providing users of fixed subscriber apparatus with the same services as users of a mobile network by allowing the fixed subscriber apparatus to read SIM cards. It is not clear what would motivate or suggest combining these two references to one of ordinary skill in the art.

"When the incentive to combine the teachings is not readily apparent, it is the duty of the Examiner to explain why the combination of the reference teachings is proper ... Absent such reasons or incentives, the teachings of the references are not combinable" (*Ex Parte Skinner*, 2 USPQ 2d 1788 (B.P.A.I. 1987)).

In the October 6, 2003 Office Action, the Examiner's explanation for the motivation to combine these two references was that "[i]t would have been obvious to one of ordinary skill at the time the invention to modify *Widegren*, such that SIM card data can be stored by the element/gateway, to provide support to any/all phone [*sic*] that use SIM cards and for central storage of SIM data" (October 6, 2003 Office Action, page 5, lines 19-21).

To the extent that the reasoning in the above passage from the October 6, 2003 Office Action is understood, the Examiner appears to use the desirability of the advantages of the present invention in order to provide a motivation for combining *Widegren* and *Veloso*. In other words, the Examiner appears to be engaged in impermissible "hindsight reconstruction", where individual elements from disparate pieces of the prior art are combined in order to create the system and/or method claimed in the present invention. *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. [The cited references] fail to suggest any motivation for, or desirability of, the

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changes espoused by the Examiner and endorsed by the board. ... Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*)

It is difficult to find or assess what the Examiner believes suggests either the combination of *Widegren* and *Veloso*, or the combination of *Widegren*, *Veloso*, and *Malmstrom* in the March 23, 2004 Final Rejection. To the extent that suggestions for combining appear to be discussed by the Examiner, and to the extent to which they are understood, they are completely insufficient to support a *prima facie* §103 obviousness rejection.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness, because there is no motivation or suggestion for making either the combination of *Widegren* and *Veloso*, or the combination of *Widegren*, *Veloso*, and *Malmstrom*, except for the desirability of the advantages provided by the applicant's present application. At least because impermissible hindsight was used in making the §103 rejection of independent Claims 1 and 13 of the present application based on the combination of *Widegren*, *Veloso*, and *Malmstrom*, the §103 rejection of independent Claims 1 and 13 is invalid.

Lastly, and perhaps most importantly for any substantive examination of the pending claims, *Widegren*, *Veloso*, and *Malmstrom*, even when impermissibly combined, neither teach nor suggest the limitations of either independent Claim 1 or independent Claim 13 of the present application.

Widegren is directed to a "wireless office gateway (WO gateway)" which is integrated into both a private telephony network (PTN) and a public land mobile network (PLMN) (lines 10-30, page 3, *Widegren*). As seen in FIG. 1 of *Widegren*, this "WO Gateway 124" is part of a "wireless office system 142" inside PLMN 102 (line 36 of page 6 to line 1 of page 7, *Widegren*). The WO Gateway 124 is connected to (i) a public cellular telephone system 140 that is also part of PLMN 102, (ii) "radio access network (RAN) 126" within the wireless office system 142, and (iii) a "private fixed telephony network (PTN) 108" (line 11 of page 6 to line 21 of page 7, *Widegren*). In essence, WO Gateway 124 allows mobile terminals in RAN 126 inside wireless

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office system 142 to act as if they were "extensions" within PTN 108 (line 22 of page 7 to line 2 of page 9, *Widegren*). However, WO Gateway 124 does not let subscribers of the public cellular system 140 use subscriber apparatus in either RAN 126 or PTN 108 as if the subscriber apparatus was a mobile terminal 114 in public cellular system 140.

On the other hand, *Veloso*, like the present invention, is directed to providing users of a subscriber apparatus with the same services as the users of a mobile network. As is stated in the Background section of the present application (lines 6-20, page 1, present application) in reference to the European application corresponding to *Veloso*:

A prior-art solution is disclosed in patent EP-779 757. Said document discloses a solution in which the users of a fixed telephone network are offered an arrangement where the users of fixed subscriber apparatus can obtain the same services as the users of a mobile network. The patent discloses a method in which a SIM card can be placed in a fixed subscriber apparatus. By means of the SIM card the fixed subscriber apparatus can be connected to a mobile switching center whereby the subscriber's subscriber data can be stored in a visitor location register.

However, the invention disclosed in said EP-779 757 has some drawbacks. In the solution according to the invention disclosed in EP-779 757, the user has to acquire a new subscriber apparatus in order to have access to the mobile network services.

This is due to the fact that the access to the mobile network services is in said invention based on the presence of a SIM card in the subscriber apparatus. The cost of new subscriber equipment will be paid direct by the end user. Moreover, in the arrangement disclosed in said publication only fixed subscriber apparatus can be attached to the mobile network.

Veloso discloses an arrangement where a SIM card containing subscriber data is inserted into the subscriber apparatus of the user in order to upload the user's subscriber data to the VLR of the local mobile switching center (MSC) (see, e.g., FIG. 1 and accompanying description, *Veloso*). In other words, the subscriber data is literally inserted into the subscriber apparatus and then transmitted via landline to a network element of a mobile telephone system.

Malmstrom is directed to a "single number service for providing integrated wireless and wireline communication networks for forwarding a call incoming to a subscriber's designated single telephone number" (Abstract, *Malmstrom*). In order to do so, a "wireline location register (WLR)"

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on the wireline network stores "subscriber mobile registration status", which is retrieved when a telephone call to the subscriber's designated single telephone number is received. *Id.* If the status indicates that the subscriber is "wireline registered", the call is routed to the subscriber's wireline destination number (see, e.g., col. 8, lines 49-65, *Malmstrom*). If the status indicates that the subscriber is "wireless registered", the WLR queries the HLR in the wireless network in order to get the subscriber's wireless destination number in order to route the call to that wireless number. *Id.* In other words, the WLR forwards the call to the appropriate location, whether in the wireline network or the wireless network.

By contrast, independent Claim 1 of the present application is reproduced below:

1. A method for connecting a subscriber system comprising a subscriber apparatus of a user to a host mobile network, comprising the steps of:
 - storing, in a network element connected to the host mobile network, subscriber data corresponding to information concerning the subscriber apparatus of the user of the subscriber system, wherein the network element associates the subscriber apparatus of the user with a mobile communication means of the user on the host mobile network;
 - emulating towards said host mobile network a first desired interface, said first desired interface being of said host mobile network;
 - emulating towards said subscriber system a second desired interface, said second desired interface being of said subscriber system; and
 - connecting signals of said subscriber system to the host mobile network and signals of the host mobile network to said subscriber system based on said stored subscriber data.

The exemplary embodiment shown in FIG. 2 of the present application and reproduced on the next page will be used to elucidate the limitations recited in Claim 1. In FIG. 2, network element 11 is connected to a Mobile Switching Center 94 of a cellular telephone network, i.e., host mobile network 90', by output unit 13, and is connected to wired telephones 21, i.e., the "subscriber apparatuses", by input unit 16. Network element 11 stores "subscriber data [which] associates [the wired telephone 21] of the user of the subscriber system with a [mobile station 91] of the user on the [cellular telephone network]". This subscriber data is used in order that the user's wired telephone 21 emulates, or mimics, the user's cellular telephone to the cellular telephone network. Specifically, output unit 13 emulates "towards said host mobile a desired first interface" so that a call from wired telephone 21 appears to be "of said host mobile network". Similarly, input unit 16 emulates "towards said subscriber system [i.e., wired telephone system] a second desired interface" so that a

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call from the cellular telephone network appears to be "of said subscriber system [i.e., wired telephone system]". Lastly, network element 11 "connect[s] signals of said subscriber system [i.e., wired telephones] to the host mobile network [i.e., cellular telephone system]" and vice-versa "based on said stored subscriber data".

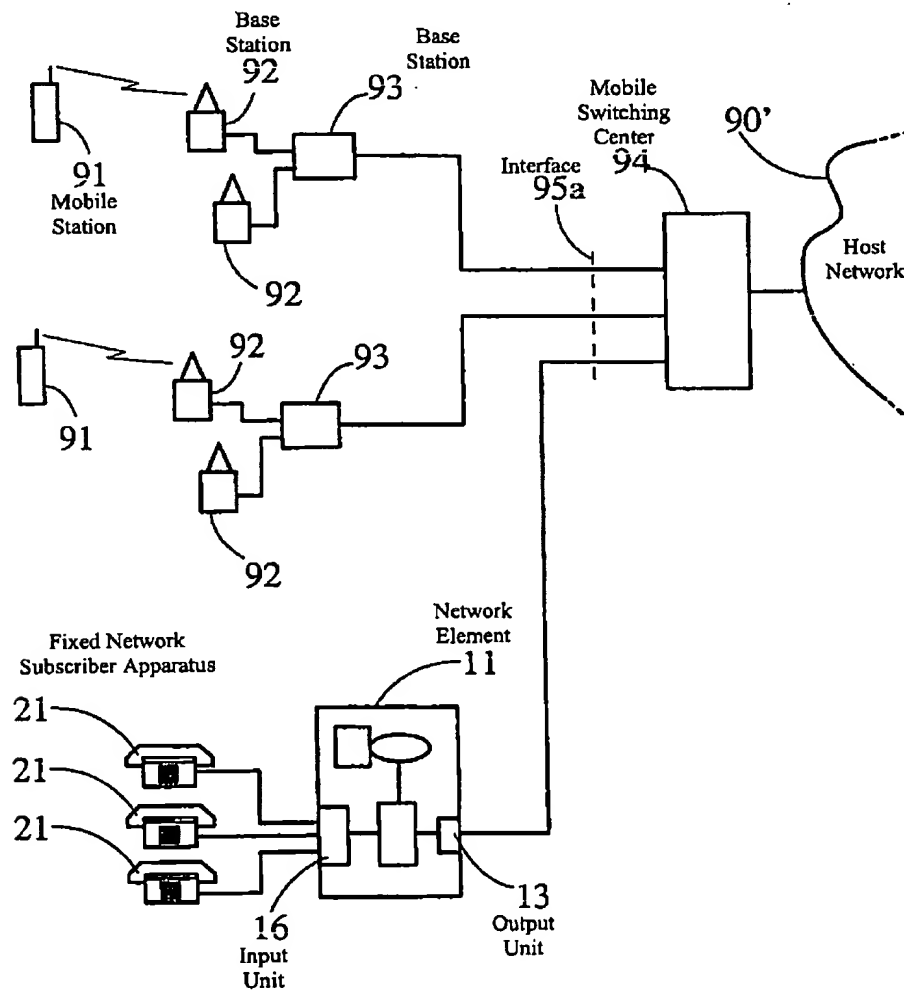


Fig. 2

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On pages 3-4 of the March 23, 2004 Final Rejection, the Examiner states that:

With regard to "desired interfaces", Malmstrom teaches wireline/wireless connectivity for forwarding/routing calls based on the location of the user which involves the use of an HLR (abstract). The ability of this system to forward calls based on the location of the user, in the examiner's opinion, reads on a "desired interface" since the system will intelligently choose an optimal communications means (eg. as desired by the user).

It is difficult to impossible to follow the logic of this rejection. The relationship between the elements being discussed in this passage and the elements actually recited in Claim 1 as reproduced and explained in reference to FIG. 2 of the application above is difficult to discern. As such, it is not possible to reply with any specificity to the March 23, 2004 Final Rejection.

The combination of *Widegren*, *Veloso*, and *Malmstrom* do not teach all of the limitations recited in either independent Claim 1 or independent Claim 13 of the present invention. Because of this, withdrawal of their rejection is respectfully requested. At least through their dependence on independent Claims 1 and 13, which are believed to be patentable over *Widegren*, *Veloso*, and *Malmstrom*, dependent Claims 2-12 and 14-20 are also believed to be patentable over *Widegren*, *Veloso*, and *Malmstrom*. Withdrawal of their rejection is respectfully requested.

In summary of the above arguments, the Final Rejection should be withdrawn because:

- (1) the Examiner has yet to respond to the applicant's traversal of the original §103 rejection on the basis that there is no suggestion, motivation, or incentive to combine *Widegren* with *Veloso*;
- (2) there is no suggestion, motivation, or incentive to combine *Widegren*, *Veloso*, and *Malmstrom*; and
- (3) the Examiner has failed to clearly explain how or why the combination of *Widegren*, *Veloso*, and *Malmstrom*, even when improperly combined, teaches or suggests the invention claimed in either independent Claim 1 or independent Claim 13 of the present application.

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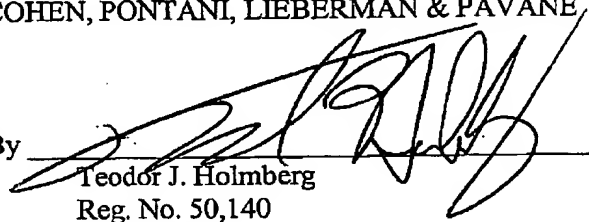
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On the basis of the foregoing, withdrawal of the Final Rejection is respectfully requested.

Respectfully submitted,

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